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PATENT APPLICATION

ATTORNEY DOCKET NO. 200209331-1

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Gary Carlson et al.

Confirmation No.: 7104

Application No.: 10/763,352

Examiner: Q. Grainger

Filing Date: January 23, 2004

Group Art Unit: 2852

Title: PRINTING DEVICE WITH LAMINATING FUNCTIONALITY

Mail Stop Appeal Brief-Patents
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TRANSMITTAL OF APPEAL BRIEF

Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on February 7, 2008.

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) **\$0.00**.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

☐ (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d)) for the total number of months checked below:

☐ 1st Month
\$120

☐ 2nd Month
\$450

☐ 3rd Month
\$1020

☐ 4th Month
\$1590

☐ The extension fee has already been filed in this application.

☒ (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account 08-2025 the sum of **\$ 0.00**. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

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Respectfully submitted,

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Dated: February 13, 2008

GARY CARLSON
and GEORGE McILVAINE

HP Docket No. 200209331-1

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Sir:

THIRD BRIEF OF APPELLANTS

This Third Brief is presented in opposition to the Examiner's newly presented rejection of claims 1-6, 8-14, 16, and 17 in the final Office action dated December 13, 2007. Although the Examiner purported to raise a new ground of rejection in the December 13, 2007 action, no new ground of rejection was raised. Furthermore, even if there had been a new ground of rejection raised, Appellants note that the Examiner inappropriately reopened prosecution to a final rejection despite the absence of any amendment or information presented in an information disclosure statement.

Nevertheless, in view of the Examiner's reopening of prosecution, Appellants have submitted a new Notice of Appeal and submit this Third Brief of Appellants, which is intended to replace the Second Brief of Appellants filed September 6, 2007.

I. REAL PARTY IN INTEREST

The real party in interest is Hewlett-Packard Development Company, LP, a limited partnership established under the laws of the State of Texas and having a principal place of business at 20555 S.H. 249 Houston, TX 77070, U.S.A. (hereinafter "HPDC"). HPDC is a Texas limited partnership and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware Corporation, headquartered in Palo Alto, CA. The general or managing partner of HPDC is HPQ Holdings, LLC.

II. RELATED APPEALS AND INTERFERENCES

There are no known related appeals or interferences.

III. STATUS OF CLAIMS

The present application was filed on January 23, 2004, with original claims 1 - 18. A first Office action was mailed February 15, 2005. Appellants cancelled claims 15 and 18, and amended claims 1, 2, 4-10, 13, and 14 in their May 10, 2005 response to the first Office action. A final Office action was mailed July 26, 2005. Appellants amended page 5 of the specification in their response sent September 26, 2005. An Office action was sent October 24, 2005. Appellants responded on November 18, 2005 by canceling claim 7 and amending claim 13. An Office action was sent February 9, 2006. Appellants responded on April 11, 2006 by amending claims 5, 13, 14, 16, and 17. A final Office action was mailed June 23, 2006. Appellants responded with remarks on August 23, 2006. An Advisory Action was mailed September 8, 2006 removing an objection to claim 5 and otherwise maintaining the June 23, 2006 rejections of all the pending claims. Following Appellants filing of a Notice of Appeal on September 19,

2006, and subsequent filing of a Brief of Appellants on November 20, 2006 and Amended Brief of Appellants on January 23, 2007, the Examiner issued a new Office action on June 25, 2007. The June 25, 2007 Office action set forth rejections identical to those set forth in the final Office action dated June 23, 2006. Appellants again filed a Notice of Appeal on August 27, 2007, and filed a Second Brief of Appellants on September 6, 2007. The Examiner issued a new final Office action on December 13, 2007, again with rejections identical to those set forth in the final Office actions dated June 23, 2006 and June 25, 2007.

Pending claims 1-6, 8-14, 16, and 17 are the claims at issue in this appeal.

IV. STATUS OF AMENDMENTS

No amendments have been made subsequent to the final Office action dated June 23, 2006.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The claimed subject matter is set forth in exemplary embodiments, which are shown and described in the application as originally filed. Particular locations in the specification and drawings are cited below in support of such claimed subject matter.

The claims at issue in this appeal are directed to a method of using a printing device having a toner fuser to laminate a media sheet with at least one laminate material sheet, and to the printing device itself.

In particular, independent claim 1 is directed to a method of using a printing device having a toner fuser to laminate a media sheet with at least one laminate material sheet, an example of which is shown in the flowchart in Fig. 8, and is described

in the specification on page 8, line 29 to page 10, line 2. The claimed method involves receiving (102) a laminate request; identifying (110) the composite media; adjusting (112) a characteristic of the toner fuser of the printing device based on the identified composite media; and passing (118) the composite media through the toner fuser to effect lamination within the printing device.

Independent claim 5 also is directed to a method of using a printing device having a toner fuser to laminate a media sheet with at least one laminate material sheet, an example of which is shown by flowchart in Fig. 8, and described in the specification on page 8, line 29 to page 10, line 2. The claimed method includes receiving (102) a laminate request; adjusting (112) the pressure exerted by the toner fuser based on identifying the media sheet and the laminate material sheet; and passing (118) the media sheet and the at least one laminate material sheet through the toner fuser to effect lamination within the printing device.

Independent claim 9 is directed to a method of using a printing device having a toner fuser to laminate a media sheet with at least one laminate material sheet, an example of which is shown in Fig. 8, and is described in the specification on page 8, line 29 to page 10, line 2. The claimed method includes receiving (102) a laminate request; adjusting (112) a characteristic of the toner fuser of the printing device; receiving (114) the media sheet and at least one laminate material sheet into a media-transport path in the printing device, wherein receiving the media sheet and at least one laminate material sheet includes receiving the media sheet and at least one laminate material sheet from an automatic feed tray of the printing device; passing (118) the media sheet

and the at least one laminate material sheet through the toner fuser to effect lamination within the printing device; and outputting (120) a laminated media sheet from the media-transport path.

Independent claim 10 is directed to a method of using a printing device having a toner fuser to laminate a media sheet with at least one laminate material sheet, an example of which is shown in Fig. 8, and is described in the specification on page 8, line 29 to page 10, line 2. The method includes receiving (102) a laminate request; displaying (106) instructions on a device display, the instructions defining how to configure the printing device to effect lamination; configuring (112) a characteristic of the toner fuser of the printing device; and passing (118) the media sheet and the at least one laminate material sheet through the toner fuser to effect lamination within the printing device.

Independent claim 13 is directed to a device with a selectively operable bypass of an image transfer mechanism, an example of which is shown in Figs. 1 and 2, and is described in the specification on page 2, line 19 to page 7, line 16. The device (10) has a media-transport path (24) having at least one media input (16, 22) and at least one media output (20), wherein the media-transport path includes a selectively operable bypass of the image-transfer mechanism (30); an image-transfer mechanism (30) positioned along the media-transport path (24); and a fuser system (32) positioned along the media-transport path (24), downstream of the image-transfer mechanism (30), and configured with at least one adjustable fusing characteristic to selectively alternatively effect either fusing of toner to a media sheet, or lamination of the media

sheet to a laminate material sheet passed through the fuser system with the media sheet.

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

A. Are claims 1-6, 8-9, 12-14, and 16-17 properly rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,894,318 to Endo et al. (Endo) in view of U.S. Patent No. 4,549,803 to Ohno et al. (Ohno)?

B. Are claims 10 and 11 properly rejected under 35 U.S.C. § 103(a) as being unpatentable over Endo in view of Ohno and U.S. Patent No. 6,516,178 to Fukushima (Fukushima)?

VII. ARGUMENT

Appellants assert that the Examiner has failed to establish *prima facie* obviousness of claims 1-6, 8-14, 16, and 17, and thus that the rejections under 35 U.S.C. § 103(a) are improper.

A. Rejections under 35 U.S.C. § 103(a)

i. Prima facie obviousness

The burden of establishing a *prima facie* case of obviousness can only be satisfied by a showing of some objective teaching in the prior art that would lead an individual to combine the relevant teachings of the references. Under 35 U.S.C. § 103, teachings of references can be combined only if there is some suggestion or incentive to do so. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art also suggests the desirability of the modification.

The law is “clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.” In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) (citations omitted).

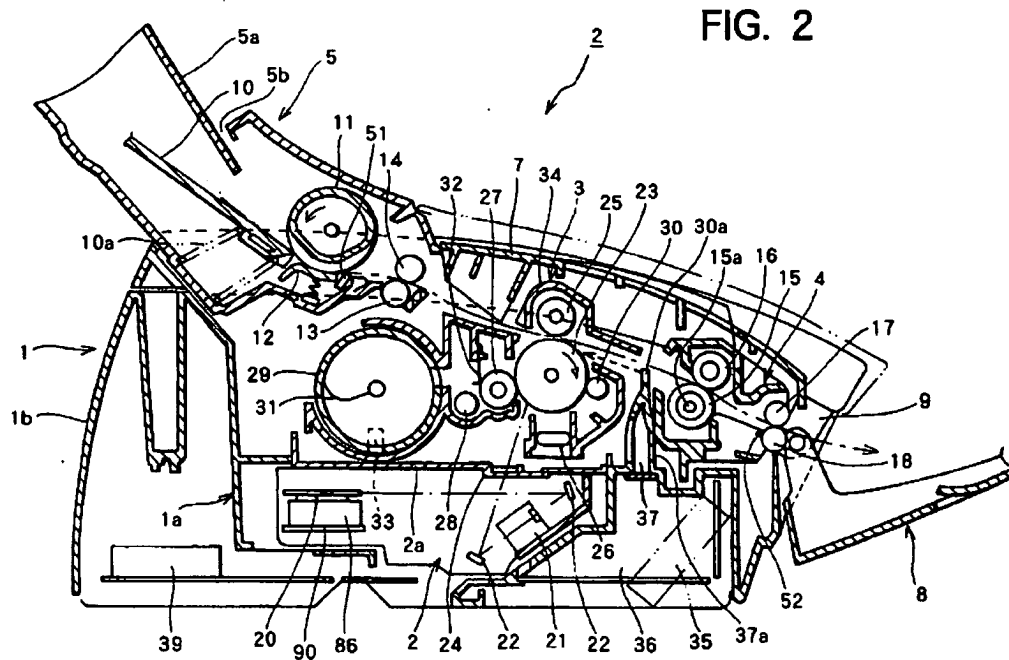
In applying 35 U.S.C. § 103, the references must suggest the desirability, and thus, the obviousness of making the combination. As stated by the Federal Circuit in In re Fritch, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992):

[T]he Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art. ‘The Examiner can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.’ ... Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so. ... This court has previously stated that ‘[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the invention.’

Id. at 1265-1266 (citations omitted). In the present application the only indication of a teaching or motivation the Examiner gives to combine Endo and Ohno is based on an erroneous reading of Ohno. Because of this, the Examiner misses that Ohno and Endo teach solutions to different technological problems and thus are nonanalogous art, inappropriate for use in a rejection under 35 U.S.C. § 103. To rely on a reference as the basis for rejection of an applicant’s invention, the reference must either be in the field of applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned. MPEP 2141.01(a).

ii. **The Endo patent**

Endo relates to a printer that may also provide lamination conditions. Fig. 2 shows the components of the Endo device:



The device of Endo includes a process unit 3 that acts as an image transfer portion of a printer, for placing an image on a document. Image fixing unit 4 is located near the image transfer portion, and contains a heat roller 15 and a pressure roller 16. Heat roller 15 is heated by an internal electrical resistance heater 15a. The speed and temperature of the rollers of the device are controlled to provide for lamination or printing within the device (Endo col. 11, lines 25-35).

iii. The Ohno patent

Ohno describes a printer that can print color images on a resin-based overhead projector film. Fig. 2 shows the color-fixing components of the Ohno device:

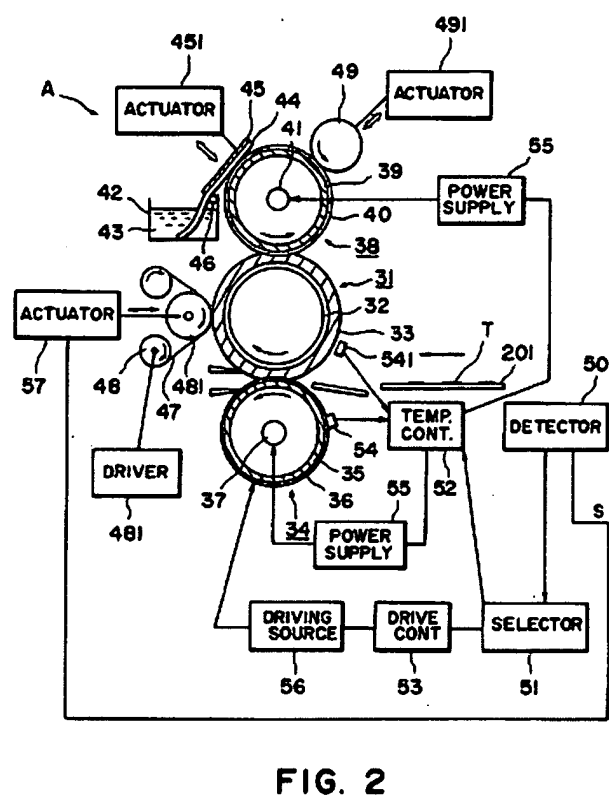


FIG. 2

The device of Ohno includes a fixing roller **31** heated by a heating roller **38**. A second fixing roller **34** is heated by an internal infrared lamp heater **37**. A cleaning web **47** is used to clean roller **31** after fixation of printer toner onto an overhead projector sheet. The printer is configured such that the surface of roller **34** (which is away from the toner on the overhead projector sheet) is hotter than the surface of roller **31** (which contacts the toner and melts it to the sheet). The device of Ohno is configured to reduce the problem of color toner adhering to the rollers when color toner is fixed to a

resin-based overhead projector sheet (Ohno col. 6, lines 24-37). Selector means 51 simultaneously changes the temperature and speed of rollers 31 and 34 to optimize fixation of color toner to an inserted overhead projector sheet.

B. Claim Rejections

As noted above, all of the pending claims stand rejected under 35 U.S.C. § 103(a) in view of a combination of at least Endo with Ohno. Because the rejections of claims 10 and 11 only add Fukushima to Endo and Ohno, Appellants will address those rejections herewith. Appellants respectfully traverse the rejections.

i. Claims 1-4, 6-8, 10-14, and 16-17

Appellants believe that the combination of Endo with Ohno is inappropriate and does not make obvious the subject matter of the pending claims. Ohno does not provide the claim element for which the Examiner cites the reference, and Ohno is not of the same field of endeavor as Endo, as it does not address the same technical problem.

First, the rejections in view of Endo and Ohno are inappropriate because Ohno does not provide the claim elements missing from Endo. The Office action states that "Ohno et al. teaches changing the characteristics of the toner fuser...when laminating a document with laminating material (column 6, lines 44-55)." (Final Office action, pg. 3). Appellants have reviewed the cited passage, and the rest of Ohno, and disagree with this characterization of the subject matter of Ohno. Though Ohno discusses, in the cited section, changing the temperature and speed of a roller in a printer, Ohno does so in the context of determining the best conditions for fixing color toner on an overhead

projector sheet. As stated in the Summary of the Invention of Ohno: "The present invention is therefore aimed at a recording apparatus...which can increase the ability of *fixation of images*, particularly color images to synthetic resin films." (Ohno, col. 3, lines 19-24; emphasis added). As such, Ohno does not teach adjusting the temperature and speed of a toner fuser when *laminating* a document.

Second, the rejections in view of Endo and Ohno are inappropriate because Ohno is not analogous art with Endo, or with the present disclosure, when the disclosure of Ohno is considered as a whole, as it must be. A prior art reference must be considered in its entirety, including portions that would lead away from the claimed invention. MPEP § 2141.02. While Ohno is structurally similar to Endo and Appellants' claimed invention, the problem solved in Ohno is not of the same field of endeavor as Endo and the claimed invention. As noted above, Ohno is directed toward determining the optimal conditions useful for fixing toner to a resin-based overhead projector sheet. In contrast, the claimed invention is directed toward partially melting, and fixing together, a resin sheet with another resin sheet or with a media sheet.

Not only is Ohno non-analogous art with Endo and Appellants' claimed invention, Ohno teaches away from its combination with Endo. In switching from a printing mode to a laminating mode, Endo teaches that one should slow down a transport speed by about 90% and simultaneously *increase* a temperature within a printing device (Endo, col. 11, lines 25-35). In contrast, Ohno teaches that when switching from printing on paper to printing on a resin sheet one should slow down the transport speed by about 80% but also *decrease* the temperature. (Ohno, col. 8, lines 27-42). In other words,

Ohno teaches altered resin-printing conditions that are incompatible with performing a lamination function in a printer. Ohno explicitly teaches printing conditions that require a change in conditions opposite to that suggested by Endo. The modification suggested by Ohno would make the printer of Endo unsuitable for its intended purpose. This makes clear that Ohno attempts to, and does, solve a different problem than Endo, and thus is not analogous art to Endo and the claimed invention.

Because Ohno is directed to solving a different technical problem than is Endo, and because Ohno teaches away from a combination with Endo, Appellants respectfully request that the rejections of claims 1-4, 6-8, and 12 be withdrawn and the pending claims allowed. The rejections of claims 10 and 11 were made based on the same combination, with the addition of Fukushima, and suffer from the same flaw. Thus, the rejections of those claims should be withdrawn and claims 10 and 11 should be allowed, as well.

ii. **Claim 5**

As noted above, claim 5 recites that the *pressure* of the toner fuser is adjusted “based on identifying the media sheet and the laminate material sheet.” Appellants note that neither Endo nor Ohno discloses adjusting a pressure applied by a toner fuser much less adjusting the pressure of the toner fuser based on identified media. The Examiner asserts that this claim element is made obvious by the disclosure in Ohno of changes to the temperature and speed of the fuser because “changing the pressure also changes the fusing ability” (Advisory Action, pg. 2). Appellants note, however, that the Examiner still has not pointed to a disclosure of changing the pressure of a toner

fuser in either Endo or Ohno. Because the Examiner cannot make that showing, neither Endo nor Ohno, nor the combination of them, can render obvious the subject matter of the pending claim. Accordingly, Appellants respectfully request withdrawal of the rejection of claim 5 and allowance of the pending claim.

iii. **Claim 9**

Claim 9 was rejected in view of Endo and Ohno, the Examiner having indicated that "a manual feed tray is an automatic feed tray. Appellants believe that the plain meanings of "manual" and "automatic" are being disregarded to facilitate this rejection. The final Office action of June 23, 2006 concedes that a manual feed tray is not an automatic feed tray when it states that "the user inserts a media sheet." (Office action, pg. 4). An automatic feed tray, as recited in claim 9, does not require a user to insert a media sheet immediately prior to performing a laminating function, as it already contains the necessary materials and can be used as a source of materials independently of a "user insert[ing] a media sheet." Appellants' specification is consistent with the different meanings of "automatic" and "manual" feed trays. An automatic feed tray is one that, for example, could be said to "store paper to be introduced into a media-transport path." (Specification, pg. 3, lines 1-2). A manual feed tray, on the other hand, is one into which a user must place media just prior to its being used in a device. (Specification, pg. 8, lines 10-12). That there is a difference between a manual feed tray and an automatic feed tray, as Appellants have used those terms, is obvious by their being shown as different structures in the Figures. An automatic feed tray is shown in Figures 1 and 2, at 22, while a manual feed tray is shown in Figures 1 and 2, at 16. Because a

manual feed tray is not an automatic feed tray, in view of the plain meanings of those terms to one of skill in the art, and in view of the different meanings given those terms in the present specification, Appellants respectfully request withdrawal of the rejection of claim 9 and allowance of the claim.

C. Summary

Appellants assert that the Examiner has not established the *prima facie* obviousness of claims 1-14, 16, and 17. Ohno does not teach lamination, for which it was cited by the Examiner. As well, Ohno is directed toward a different technical problem than are Endo and Appellants' disclosure. As such, the combination of Endo and Ohno is inappropriate and does not make obvious the pending claims. Regarding claim 5, neither Endo nor Ohno discloses adjusting a toner fuser *pressure* based on identifying a media sheet and a laminate material sheet. Regarding claim 9, neither Endo nor Ohno teaches using an automatic feed tray in a lamination method, and a manual feed tray, in its plain meaning, is not an automatic feed tray. Accordingly, the rejection of claims 1-14, 16, and 17 is improper.

VIII. CLAIMS APPENDIX

1. (Previously Presented) A method of using a printing device having a toner fuser to laminate a composite media including media sheet with at least one laminate material sheet, the method comprising:

receiving a laminate request;

identifying the composite media;

adjusting a characteristic of the toner fuser of the printing device based on the identified composite media; and

passing the composite media through the toner fuser to effect lamination within the printing device.
2. (Previously Presented) The method of claim 1, wherein passing the composite media through the toner fuser includes passing the media sheet through the toner fuser interposed a pair of laminate material sheets.
3. (Original) The method of claim 1, wherein adjusting the characteristic of the toner fuser includes adjusting a temperature of the toner fuser.
4. (Previously Presented) The method of claim 1, wherein adjusting the characteristic of the toner fuser includes adjusting the speed at which the composite media passes through the toner fuser.

5. (Previously Presented) A method of using a printing device having a toner fuser to laminate a media sheet with at least one laminate material sheet, the method comprising:

- receiving a laminate request;
- adjusting the pressure exerted by the toner fuser based on identifying the media sheet and the laminate material sheet; and
- passing the media sheet and the at least one laminate material sheet through the toner fuser to effect lamination within the printing device.

6. (Previously Presented) The method of claim 1, further comprising:

- receiving the composite media into a media-transport path in the printing device;
- transporting the composite media along the media-transport path through the toner fuser; and
- outputting a laminated media sheet from the media-transport path.

7. (Cancelled)

8. (Previously Presented) The method of claim 6, wherein receiving the composite media includes receiving the media sheet and at least one laminate material sheet from a manual feed tray of the printing device.

9. (Previously Presented) A method of using a printing device having a toner fuser to laminate a media sheet with at least one laminate material sheet, the method comprising:

- receiving a laminate request;
- adjusting a characteristic of the toner fuser of the printing device;
- receiving the media sheet and at least one laminate material sheet into a media-transport path in the printing device, wherein receiving the media sheet and at least one

lamine material sheet includes receiving the media sheet and at least one laminate material sheet from an automatic feed tray of the printing device;

passing the media sheet and the at least one laminate material sheet through the toner fuser to effect lamination within the printing device; and

outputting a laminated media sheet from the media-transport path.

10. (Previously Presented) A method of using a printing device having a toner fuser to laminate a media sheet with at least one laminate material sheet, the method comprising:

receiving a laminate request;

displaying instructions on a device display, the instructions defining how to configure the printing device to effect lamination;

configuring a characteristic of the toner fuser of the printing device; and

passing the media sheet and the at least one laminate material sheet through the toner fuser to effect lamination within the printing device.

11. (Original) The method of claim 10, wherein displaying instructions includes displaying instructions to open and load a manual feed tray.

12. (Original) The method of claim 1, wherein receiving the laminate request includes receiving the laminate request via a printing device user interface.

13. (Previously Presented) A device comprising:

a media-transport path having at least one media input and at least one media output, wherein the media-transport path includes a selectively operable bypass of the image-transfer mechanism;

an image-transfer mechanism positioned along the media-transport path; and

a fuser system positioned along the media-transport path, downstream of the image-transfer mechanism, and configured with at least one adjustable fusing characteristic to selectively alternatively effect either fusing of toner to a media sheet, or lamination of the media sheet to a laminate material sheet passed through the fuser system with the media sheet.

14. (Previously Presented) The device of claim 13, wherein the at least one adjustable fusing characteristic includes one or more of fuser temperature, fuser speed, and fuser pressure.

15. (Cancelled)

16. (Previously Presented) The device of claim 13, wherein the input of the media-transport path includes a manual feed tray.

17. (Previously Presented) The device of claim 14, wherein the media-transport path moves media substantially in a first direction.

18. (Cancelled)

IX. EVIDENCE APPENDIX

None.

X. RELATED PROCEEDINGS APPENDIX

None.

Respectfully submitted,

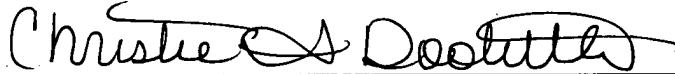
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Christie A. Doolittle